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OFFICE OF PETITIONS

In re Application of
Robert L. Beck et al
Application No. 09/835,288
Filed: April 13, 2001
Attorney Docket No. 3591/1102

: DECISION
: ON
: PETITION

This is a decision on the combined petition filed on December 24, 2008, which includes:

- a petition under 37 CFR 1.137(a) to revive an unavoidably abandoned application, and

- an alternative petition under 37 CFR 1.137(b) to revive an unintentionally abandoned application.

This decision also addresses the paper filed on March 16, 2010 entitled "Supplement to Petition Pursuant to 37 CFR 1.137(b) to Revive an Unintentionally Abandoned Application" ("the March 16, 2010 supplement to the combined petition"), and the paper, also filed on March 16, 2010, entitled " Revocation of Former Powers of Attorney and New Power of Attorney by Assignee of Entire Interest" (the March 16, 2010 combined statement under 3.73(b), power of attorney, and change of correspondence address").

The combined petition filed on December 24, 2008, the March 16, 2010 supplement to the combined petition, the March 16, 2010 combined statement under 3.73(b), power of attorney and change of correspondence address, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

The $540 petition fee set forth in 37 CFR 1.17(l) for the present petition under 37 CFR 1.137(a), and the petition fee of $1620 set forth in 37 CFR 1.17(m) for the present petition under 37 CFR 1.137(b), will be charged to deposit account no. 12-1216 as authorized on page 2 of the December 24, 2008 combined petition, and on pages 1-2 of the March 16, 2010 supplement to the combined petition.

SUMMARY

The petition under 37 CFR 1.137(a) to revive an unavoidably abandoned application, filed on December 24, 2008, is **dismissed**. The alternative petition under 37 CFR 1.137(b) to revive an unintentionally abandoned application, filed on December 24, 2008 and on March 16, 2010, is **granted**. The March 16, 2010 combined statement under 3.73(b), power of attorney and change of correspondence address, is **ineffective**.

DECISION

The Petition under 37 CFR 1.137(a) to Revive an Unavoidably Abandoned Application

On May 14, 2003, a nonfinal Office action was mailed by the Office, setting a three-month shortened statutory period for reply. On January 27, 2004, a notice of abandonment was mailed by the Office, stating that the application was abandoned "in view of applicant's failure to timely file a proper reply to the Office letter" mailed on May 14, 2003. The present application was abandoned as of August 15, 2003. The present petition under 37 CFR 1.137(a), however, was not filed until December 24, 2008.

In evaluating a petition under 37 CFR 1.137, three periods are considered:[1]

(1) the delay in the reply that originally resulted in the abandonment,
(2) the delay in filing an initial petition under 37 CFR 1.137 to revive the application, and
(3) the delay in filing a *grantable* petition under 37 CFR 1.137 to revive the application.

Regarding period (1), the applicant has provided evidence sufficient to show that the delay in the reply that originally resulted in the abandonment was unavoidable. Period (3) is not applicable, because the present petition is the initial petition filed under 37 CFR 1.137.[2] Regarding period (2), however, the present petition lacks sufficient evidence to show that the delay in filing the initial petition under 37 CFR 1.137(a) was unavoidable.

The applicant has provided evidence that the applicant was notified of the abandoned status of the application on July 14, 2008. The present petition under 37 CFR 1.137(a), however, was not filed by the applicant until December 24, 2008, more than five months later.

MPEP 711.03(C), subsection II D, provides, in pertinent part:

> Where a petition pursuant to 37 CFR 1.137(a) . . . is not filed within 3 months of the date the applicant is first notified that the application is abandoned . . . the Office will require a showing as to how the delay between the date the applicant was first notified that the application was abandoned and the date a 37 CFR 1.137(a) petition was filed was "unavoidable".

The applicant has presented evidence that Mr. Prendergast, a former attorney of record, may have intentionally concealed the abandonment of this application from his law firm, Brinks Hofer Gilson and Lione ("Brinks Hofer"). The applicant also states that on September 4, 2008, Brinks Hofer informed the applicant of the results of an investigation of Mr. Prendergast's office and files regarding an unrelated case, and that further investigation into the records of Brinks Hofer "over the following weeks provided the additional evidence of Mr. Prendergast's activities

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[1] See MPEP 711.03(c), subsection II D.

[2] For example, if a timely filed petition under 37 CFR 1.137 were dismissed on other grounds, applicant cannot intentionally delay the filing of a renewed petition Applicant must provide a showing that any delay in a renewed, and grantable, petition is either unavoidable (for petitions under 37 CFR 1.137(a)) or unintentional (for petitions under 37 CFR 1.137(b)). See *In re Application of Takao*, 1990 Comm'r Pat. LEXIS 6, 17 USPQ2d 1155 (Comm'r Pat. 1990).

that forms the basis for this petition." The evidence and statements presented by the applicant may reasonably show how the five-month delay between July 17, 2008, the date that applicant states that he was first notified of the abandonment, and December 24, 2008, the filing date of the present petition, was unintentional. However, the applicant has not clearly shown how the five-month delay was *unavoidable*. For example, the applicant has not explained what actions the applicant may have taken, including any communications between the applicant and Brinks Hofer, between July 17, 2008, when applicant was notified of the abandonment, and August 21, 2008, when Brinks Hofer informed the applicant that Mr. Prendergast had left the law firm. As another example, the applicant has not provided evidence showing the stage of the investigation on October 14, 2008, three months after the applicant was first notified of the abandonment, and why an additional ten-week delay in order to file the present petition was unavoidable.

In addition, a grantable petition under 37 CFR 1.137(a) must be accompanied by (1) a reply to the outstanding Office action, (2) the petition fee set forth in 37 CFR 1.17(l), (3) a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unavoidable,[3] and (4) any terminal disclaimer (and fee) required by 37 CFR 1.137(d).

The applicant has submitted, with the present petition filed on December 24, 2008, an amendment and a petition fee under 37 CFR 37 CFR 1.17(l), which satisfy items (1) and (2), respectively. Regarding item (4), no terminal disclaimer is required pursuant to 37 CFR 1.137(d), because the present application was filed after June 5, 1995. The applicant has not, however, satisfied item (3), because the applicant has not shown that the *entire* delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unavoidable.

Furthermore, where, as here, a petition under 37 CFR 1.137(a) is filed more than one year after the date of the abandonment of the application,[4] the applicant must also provide (see MPEP 711.03(c), subsection II D):

A. further information as to when the applicant (or applicant's representative) first became aware of the abandonment of the application; and

B. a showing as to how the delay in discovering the abandoned status of the application occurred despite the exercise of due care or diligence on the part of the applicant (or applicant's representative).

The applicant has provided, with the present petition, a further showing as to when the applicant first became aware of the abandonment of the application. The applicant has not, however, provided a sufficient showing as to how the *entire* delay in discovering the abandoned status of the application occurred despite the exercise of due care or diligence on the part of the applicant.

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[3] See 35 U.S.C. 133.
[4] March 22, 2007.

In determining if the delay was unavoidable, courts have adopted the standard of due care of a reasonably prudent person:

> The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. *In re Mattullath* , 38 App. D.C. 497, 514-15 (1912), quoting and adopting *Ex Parte Pratt*, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).[5]

The applicant has presented evidence that Mr. Prendergast may have intentionally concealed the abandonment of this application from his law firm, Brinks Hofer. The applicant has not, however, provided sufficient evidence that the *entire* delay in discovering the abandoned status of the application, from August 15, 2003, the date of the abandonment of the application, until July 17, 2008, the date that the applicant was informed of the abandonment of the application by Brinks Hofer,[6] occurred despite *applicant's* diligence in prosecuting the application.[7]

The applicant has presented evidence showing that once, on October 5, 2005, more than two years after the due date for the reply to the outstanding Office action, applicant communicated with Brinks Hofer, inquiring specifically about the status of the present application.[8] The applicant has also presented evidence that on April 25, 2008, nearly five years after the due date for the reply to the outstanding Office action, the applicant requested Brinks Hofer to provide a general list of "all data for Herman Miller even if cases are abandoned or expired",[9] and that on April 29, 2008, Brinks Hofer submitted "the reports requested".[10] Assuming that the copy of the spreadsheet provided in Exhibit C is a copy of the report submitted by Brinks Hofer to Debra Miller on April 29, 2008, the spreadsheet shows that the present application was listed as "pending" as of that date.

Evidence has not been presented, however, of any communication between applicant and his former counsel regarding the status of this application, including any response by former counsel to applicant's October 5, 2005 inquiry, until April 25, 2008, more than two and a half years after applicant's initial October 5, 2005 inquiry. Furthermore, the applicant has not presented evidence of any inquiry by the applicant *specifically* into the status of this application, either by contacting his former counsel or by contacting the Office, other than the one inquiry on October 5, 2005, during the entire time period between August 14, 2003, the due date for the reply to the

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[5] See also *Ray v. Lehman*, 55 F.3d 606, 609, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) ("Under . . . [35 U.S.C.] § 133, . . . the standard is unavoidable delay . . . in order to satisfy this standard, one must show that he exercised the due care of a reasonably prudent person").

[6] See item no. 12 on page 4 of the December 24, 2008 petition, as well as Exhibit D.

[7] Decisions on revival are made on a "case-by-case basis, taking of the all facts and circumstances into account". *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). A petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was unavoidable. See, e.g., *Haines v. Quigg*, 673 F. Supp. 314, 5 USPQ2d 1130 (N. D. Ind. 1987). See also MPEP 711.03(c), subsection II C 2.

[8] See item no. 7 on page 4 of the December 24, 2008 petition, as well as Exhibit B-1.

[9] See Exhibit C, the copy of the April 25, 2008 e-mail from Debra Miller to Mark Rolla and Andrew Stover of Brinks Hofer.

[10] See Exhibit C, the copy of the April 29, 2008 e-mail from Brinks Hofer to Debra Miller

outstanding Office action, and July 17, 2008, when the applicant learned of the abandonment, more than five years after the due date for the reply.[11]

The applicant states that he did not receive a copy of the May 14, 2003 nonfinal Office action.[12] However, the applicant does not state whether the applicant was aware of the Office action, even if the applicant did not receive a copy from his former counsel. The applicant submits, as proof that the applicant believed that the present application was pending, copies of bills submitted by Mr. Prendergast on June 7, 2004, for "drafting claims", and, particularly, on November 23, 2004, for "reviewing correspondence from Patent Office".[13] The applicant does not explain, however, whether the applicant inquired as to why Mr. Prendergast was drafting claims, if not for the purpose of drafting a response to an Office action, or whether the applicant inquired regarding what correspondence from the Office was being reviewed by Mr. Prendergast.

For the reasons given above, the applicant has not submitted sufficient evidence showing:

1. how the five-month delay between July 17, 2008, the date that the applicant states that he was first notified of the abandonment of the application, and December 24, 2008, the filing date of present petition under 37 CFR 1.137(a), was unavoidable,

2. how the *entire* delay in discovering the abandonment of the application occurred despite the exercise, by the applicant, of due care and diligence in prosecuting the application, and

3. how the *entire* delay in filing the required reply from August 14, 2003, the due date for the reply, until the filing of a grantable petition was unavoidable, pursuant to 37 CFR 1.137(a)(3).[14]

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[11] Exhibit B-3 includes a copy of an August 17, 2007 e-mail from applicant to Mr. Andrew Stover of Brinks Hofer, requesting "a list of US and Foreign patents that have gone abandoned or expired during the three-month period from May 1, 2007 through July 31, 2007". This e-mail, however, does not request the status of this application, nor would the status of this application be expected to be included in this list, since the present application became abandoned as of August 15, 2003, which was not within the three-month period requested by applicant in his August 17, 2007 e-mail.

[12] The applicant also states that applicant never received the notice of abandonment. However, abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a notice of abandonment. See *Lorenz v. Finkl*, 333 F.2d 885, 142 USPQ 26, (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

[13] See Exhibit B-2, the copy of the bill for services on June 7, 2004 by "WF Prendergast", and the copy of the bill for services on November 23, 2004 by "WF Prendergast".

[14] The applicant cites *In re Lonardo*, 1990 Commr. Pat. LEXIS 18, 17 USPQ2d 1455 (Comm'r Pat. 1990), in which unavoidable delay was found where applicant's representative concealed the abandonment of the application from the applicant. In *Lonardo*, the diligence of both the applicant's representative, and of the applicant, was considered. "Proper considerations include the extent of diligence exhibited by the petitioner himself and by his attorney, in connection with the delay for which the application became abandoned and also with their respective efforts to revive the abandoned application." *Lonardo*, 17 USPQ2d at 1455. In *Lonardo*, however, the applicant made more than one specific inquiry, with his former counsel, into the status of the application. See also *Huston v. Ladner*, 973 F.2d 1564, 23 USPQ2d 1910 (Fed. Cir. 1992), in which the court declined to hold that "attorney negligence" constituted good cause for excusing the failure to meet the Office requirement, expressly stating that the court was not bound by *Lonardo*.

Accordingly, the petition under 37 CFR 1.137(a), filed on December 24, 2008, is **dismissed**.

The Petition under 37 CFR 1.137(b) to Revive an Unintentionally Abandoned Application

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) a reply to the outstanding Office action, (2) the petition fee set forth in 37 CFR 1.17(m), and (3) a proper statement under 37 CFR 1.137(b)(3) that the entire delay in filing the required reply from the due date of the reply to the filing of a grantable petition under 37 CFR 1.137(b) was unintentional.[15] The applicant has filed an amendment[16] and a petition fee under 37 CFR 1.17(m), which satisfy items (1) and (2), respectively.[17]

A statement under 37 CFR 1.137(b)(3) has been submitted with the March 16, 2010 supplement to the combined petition, which satisfies item (3).

In accepting the statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, the United States Patent and Trademark Office ("the Office") is relying on the duty of candor and good faith of the applicant and of applicant's representative. See also 37 CFR 1.4(d)(4), which incorporates 37 CFR 11.18(b), and *Changes to Patent Practice and Procedure,* 62 Fed. Reg. 53131, 53160, 53178; 1203 *Off. Gaz. Pat. Office* 63, 88, 103 (responses to comment nos. 64 and 109) (October 21,.1997) (final rule) (applicant's representative is obligated under [former] 37 CFR 10.18(b) [now 37 CFR 11.18(b)] to inquire into the underlying facts and circumstances when providing the statement required by 37 CFR 1.137(b)(3) to the Office). Furthermore, while the December 24, 2008 combined petition and the March 16, 2010 supplement to the combined petition, are signed by an attorney who is not of record in this application, the signatures appearing on the December 24, 2008 combined petition and on the March 16, 2010 supplement to the combined petition constitute a representation to the Office that the signing attorney has made an inquiry in accordance with 37 CFR 11.18(b), to ascertain that the delay was unintentional.

Accordingly, based on the certification under 37 CFR 1.4(d)(4), which incorporates 37 CFR 11.18(b), and on the specific facts and circumstances of this application, the petition under 37 CFR 1.137(b) to revive an unintentionally abandoned application, filed on December 24, 2008 and on March 16, 2010, is **granted**.

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[15]Regarding 37 CFR 1.137(b)(4), no terminal disclaimer is required pursuant to 37 CFR 1.137(d), because the present application was filed after June 5, 1995.

[16] The grant of a petition under 37 CFR 1.137 is not a determination that any reply under 37 CFR 1.111 is complete. "Where the proposed reply is to a non-final Office action, the petition may be granted if the reply appears to be *bona fide*. After revival of the application, the patent examiner may, upon more detailed review, determine that the reply is lacking in some respect." See MPEP 711.03(c) II A 2 (a).

[17] The amendment was filed with the present petition on December 24, 2008. The authorization to charge the petition fee to the deposit account of applicant's representative appears on page 2 of the March 16, 2010 supplement to the combined petition, entitled "Supplement to Petition Pursuant to 37 CFR 1.137(b) to Revive an Unintentionally Abandoned Application".

The March 16, 2010 Combined Statement under 37 CFR 3.73(b), Power of Attorney, and Change of Correspondence Address

The paper filed on March 16, 2010, entitled "Revocation of Former Powers of Attorney and New Power of Attorney by Assignee of Entire Interest" ("the March 16, 2010 combined statement under 37 CFR 3.73(b), power of attorney, and change of correspondence address"), is **ineffective**. 37 CFR 3.73(b)(2) provides, in pertinent part:

> The submission establishing ownership must show that the person signing the submission is a person authorized to act on behalf of the assignee by:
>
> (i) Including a statement that the person signing the submission is authorized to act on behalf of the assignee; or
>
> (ii) Being signed by a person having apparent authority to sign on behalf of the assignee, e.g., an officer of the assignee.

The statement under 37 CFR 3.73(b) fails to include a statement, pursuant to 37 CFR 3.73(b)(2)(i), that the person signing the statement under 3.73(b) is authorized to act on behalf of the assignee. In addition, the statement under 37 CFR 3.73(b) is signed by a person having the title of Associate General Counsel, who is not a person having apparent authority to sign on behalf of the assignee pursuant to 37 CFR 3.73(b)(2)(ii). See MPEP 324, subsection V (A), which provides, in pertinent part (emphasis in bold added):

> . . . An officer (chief executive officer, president, vice-president, secretary, or treasurer) is presumed to have authority to sign on behalf of the organization. The signature of the chairman of the board of directors is acceptable, but not the signature of an individual director. Modifications of these basic titles are acceptable, such as vice-president for sales, executive vice-president, assistant treasurer, vice-chairman of the board of directors . . . **A person having a title (administrator, general counsel) that does not clearly set forth that person as an officer of the assignee is not presumed to have authority to sign the submission on behalf of the assignee.**

For this reason, the combined statement under 37 CFR 3.73(b), power of attorney, and change of correspondence address, filed on March 16, 2010, is **ineffective**.

For the reasons given above, the patent practitioner who filed this petition, Mr. Charles H. Mottier, of Leydig, Voit, & Mayer, Ltd., is not of record in this application. A courtesy copy of this decision will be mailed to the address of Mr. Mottier. However, in the absence of a properly executed power of attorney and change of correspondence address in this application, all future correspondence will be mailed solely to the address of record.

CONCLUSION

- The petition under 37 CFR 1.137(a) to revive an unavoidably abandoned application, filed on December 24, 2008, is **dismissed**.

- The alternative petition under 37 CFR 1.137(b) to revive an unintentionally abandoned application, filed on December 24, 2008 and on March 16, 2010, is **granted**.

- The combined statement under 37 CFR 3.73(b), power of attorney and change of correspondence address, filed on March 16, 2010, is **ineffective**.

- This application is being referred to Technology Center Art Unit 3637 for processing of the amendment filed on December 24, 2008.

- Any inquiry concerning this decision should be directed to Cynthia L. Nessler, Senior Legal Advisor, at (571) 272-7724.

Brian E. Hanlon

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